



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,038	06/27/2001	Nikhil M. Deshpande	884.484US1	3389

21186 7590 09/09/2005

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402-0938

EXAMINER

GESESSE, TILAHUN

ART UNIT	PAPER NUMBER
----------	--------------

2684

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,038

Applicant(s)

DESHPANDE ET AL.

Examiner

Tilahun B. Gesessse

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This in response to applicant's argument filed June 23, 2005, in which claims 1 through 31 are pending.

Response to Arguments

Applicant's arguments filed June 23, 2005 have been fully considered but they are not persuasive.

On page 8, third paragraph of applicant's argument to the office action, applicant argued that Mueller does not teach "means for interrogating a plurality of wireless network access service providers . . ." wherein the plurality of service providers are queried to gather information related to service offerings thereof.. .".

The examiner disagrees applicant remarks. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., wherein the plurality of service providers are queried) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Further more, Mueller teaches interrogating service providers (such as GSM, DCS 1800, DECT, D-AMPS or IS-95 (CDMA) to select best service provider in the region of overlap plurality of service providers as shown in figure 2 and 3-4).

On page 9, second paragraph of applicant's response, applicant argued that Mueller et al. fails to teach a communication device that interrogates a plurality of

Art Unit: 2684

wireless network access service providers to gather information related to service offerings thereof, as recited in claim 1.

The examiner disagrees applicant's. Mueller teaches a communication device that interrogates a plurality of wireless network access service providers to gather information related to service offerings (see column 5, line 63-column 6, line 23).

On page 9, third paragraph of applicant's response , applicant argued that Mueller does not teach "means for obtaining a provider selection criterion associated with a user of said communication device.".

The examiner disagrees. Mueller teaches means for obtaining a provider selection criterion associated with a user of said communication device. (see column 5, line 63-column 6, line 23).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

To sum up, the applied prior art in view of applicant's argument , the applied prior art teaches the broad recitation of applicant claim invention, the rejection is proper and is maintained .

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2684

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-10,13-31 are rejected under 35 U.S.C. 102(a) as being anticipated by Mueller et al "Mueller" (US 6,185,413).

As to claims 1,13,Mueller discloses a communication device (14) means for interrogating (9) a plurality of wireless network access service providers to gather information related to service offering(column 3, lines 64-column 4, lines 10, column 10, lines 43-68 and figures 3a and 3b)

Mueller discloses means for obtaining a provider selection criterion associated with a user of the communication device (column 5, line 63-column 6, line 40) and means for selecting a service provider from the plurality of wireless network access service providers to provide wireless access to a network for the communication device based on the provider selection criteria and the information (column 5, line 63-column 6, line 40 and figure 1-3).

As to claims 2, Mueller discloses means for wirelessly transmitting a separate interrogation signal for each of the plurality of the plurality of wireless network access service providers (column 10, lines 43-68 and figure 3a & 3b).

As to claims 3, 15-18 Mueller discloses the separate interrogating signal includes an identifier uniquely identifying a corresponding service provider (see column 8,line 34 –column 9,line 40 and figure 2).

As to claim 4,Mueller discloses the information includes information related to a cost of service offered by a first wireless network access service provider (column 9, lines 26-40).

Art Unit: 2684

As to claim 5, Mueller discloses the information includes to connection performance available from a first wireless network access service provider (abstract).

As to claims 6,19-21, Mueller discloses information related to a per user bandwidth available from a first wireless network access service provider (see figure 2).

As to claims 7,28 Mueller discloses means of measuring a connection bandwidth associated with a first wireless network access service provider (See figure 2).

As to claim 8, Mueller discloses means for requesting a relatively short duration connection from a first wireless network access service provider to allow a connection bandwidth of the first wireless network access service provider to be measured by the communication device (column 4, lines 30-49).

As to claims 9-10,Mueller discloses the means for prompting a user of the communication device for the provider selection criteria using an input out device (column 9, lines 41-68).

Claim 14, Mueller discloses identifying a plurality of network access service providers includes transmitting at least one inquiry signal and receiving response signals from at least two network access service providers.(see figure 1).

As to claims 22-25 Mueller discloses a computer readable medium (8) having program instructions stored thereon for performing (GSM DECT) , when executed within a digital processing device, a method for procuring wireless access to a network interrogating a plurality of network access service providers for information relating to service offerings (column 5, line 63-column 6, line 40 and figure 1-3).; and selecting a

service provider from the plurality of network access service providers based on the information and a selection criterion (column 8, lines 32-68 and figure 1)

Claims 26,29, Mueller discloses a communication device means for interrogating (9)a plurality of wireless network access service providers to gather information related to service offering ((column 5, line 63-column 6, line 40 and figure 1-3),means for obtaining a provider selection criterion associated with a user of the communication device and means for selecting a service provider from the plurality of wireless network access service providers to provide wireless access to a network for the communication device based on the provider selection criteria and the information ((column 5, line 63-column 6, line 40 and figure 1-3 and column 10, lines 43-68).

Claim 27, Mueller discloses a memory to store said provider selection criterion, wherein said selection function retrieves said provider selection criterion from said memory for use in selecting said service provider(#4 of figure 1 and figure 2).

Claims 30-31, Mueller discloses a memory including a list of network access service providers that provide network access services to the public, said plurality of network access service providers that are active in said vicinity of said communication device representing a subset of said service providers on said list (#8 of figure 1 and figure 2)

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2684

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller in view of Pecen et al (6,466,804).

As to claims 11 and 12, Mueller does not expressly teach a removable memory card and a subscriber identification module (SIM). However, Pecen et al discloses a server device 200, such as a mobile subscriber unit, having a SIM card 202 intended for use by a signal user inserted within server device 200 (column 3, lines 22-38 and figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was to utilize a removable memory card, for accessing a communication using SIM card, as taught by Pecen, in order to identify the service provider using information stored in the smart card.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2684

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 571-272-7879. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882.

On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/2/05
Tilahun B. Gesesse
TILAHUN GESESSE
PRIMARY EXAMINER